

of storing the agent therein or passing the agent therethrough when the plurality of protrusions have pierced the body surface and said connecting medium is placed in  
D2  
cancel contact with said body surface.

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## REMARKS

Currently pending are claims 1-8, 10-21, and 23-30. No claims have been cancelled and no new claims added by the present amendment. Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

### A. Claim Rejections Under § 112

The Examiner has rejected claims 1-8, 10-21 and 28 and 29 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner has asserted that it is not clear what body surface applicant is referring to in line 8: "the skin body surface, the body surface of the proximal side or the distal side."

There is only one body surface. The member has two sides, one of which is proximal to the body surface. This side is the body-surface-proximal side. The phrase "body-surface-proximal" functions as an adjective modifying the word "side". The member has a second side which is distal, or away from the one body surface.

This second side is the body-surface-distal side. The phrase “body-surface-distal” functions as an adjective modifying the word “side”.

The member also has a first and a second surface. The first surface is on the body-surface-proximal side of the member. The second surface is on the body-surface-distal side of the member.

Thus when the claim references “...extending towards the body surface”, there is no ambiguity because there is only one body surface.

However, to provide further clarification, the Applicant has amended the applicable portion of the claims to read “body-surface-proximal” and “body-surface-distal” to further emphasize the that these phrases function as adjectives. In addition, the phrase “..extending toward the body surface” has been canceled because it was redundant.

Applicant respectfully requests that the § 112, second paragraph rejection be withdrawn.

#### **B. Rejection under 35 U.S.C. 102 over Lerner and Kellet**

The Examiner has rejected claims 1-5,10-11, 14-15, 18-20, 28 and 29 as being obvious over Lerner (USPN 2,922,425) and has also rejected claims 1, 8, 10-11, and 18-21 over Kellet (USPN 5,261,426).

The claims have been amended to require that the protrusions be capable of and actually do penetrate the body surface.

Lerner is directed to a device for apply a treating liquid to hair especially when wound around curlers. Lerner discloses protrusions, referred to as Projecting Infusions Members 14. However these Members are disclosed as being inserted into the hair as it is rolled on a curler for the purpose to infusing the treating liquid onto the hair. Lerner also specifically discloses that its purpose is to “proving an applicator for applying a liquid treating material such as a permanent waving lotion to the hair with a minimum of loss and a minimum of contact between the lotion and the scalp.” Column 1, lines 37-41. Lerner clearly teaches away from the protrusion having any contact, let alone surface penetrating contact of the Projecting Infusion Members with a body surface.

Kellet discloses a hair brush having a foam pad impregnated with various hair treating formulations, such as styling and conditioning agents. The foam pad is inserted upon the tines of styling brush. As the brush is drawn through the hair in a conventional manner, the hair is brought into contact with the foam pad and the styling agents found thereon. See Column 15, lines 47-56.

Again, there is no disclosure in Kellet of tines of the brush penetrating the scalp. As clearly disclosed, the brush is used in a conventional manner which would not include penetrating the scalp with the brush.

Because there are elements of Applicants’ claims that are not disclosed by either of the § 102 references Lerner or Kellet, Applicants respectfully request that the § 102 rejection be withdrawn.



**C. Rejection under 35 U.S.C. § 103 over Lerner in view of Gerstel**

The Examiner has rejected Claim 12 as being obvious over Lerner (USPN 2,922,425) and Gerstel (USPN 3,964,482).

Lerner is directed to a device for apply various hair treatment lotions and tonics to the hair while at the same time minimizing the contact between the applied lotion or tonic and the scalp.

*One object of the present invention is to provide an applicator for applying a liquid treating material such as a permanent waving lotion to the hair with a minimum of loss and a minimum of contact between the lotion and the scalp.*

Column 1, lines 36-40.

As asserted by the Examiner, Lerner fails to disclose puncturing protrusions. The Examiner further asserts that this failure is cured by combining Lerner with Gerstel which does disclose such protrusions.

However, one cannot combine elements from two references if the combination results in an inoperative device. To have added body surface penetration protrusions to Lerner, which clearly stated that its intended purpose was to minimize contact of the liquid treating solution with the scalp, would have rendered the Lerner patent inoperable for its intended purpose.

Footnote 12. This court has previously found a proposed modification inappropriate for an obviousness inquiry when the modification rendered the prior art reference inoperable for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). *In re Fritch* (CAFC) 23 USPQ2d 1780 (8/11/1992).

Applicant respectfully requests the withdrawal of the § 103 rejection.



## CONCLUSION

As all objections put forth by the examiner have been addressed by the amendments to the claims contained herein and by the remarks provided, Applicants respectfully assert that the application is in condition for allowance, notice of which is earnestly solicited.

Respectfully submitted,

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Version With Markings To Show Changes Made

1. (amended three times) A device for introducing or withdrawing an agent through a body surface, comprising:

a member having a ~~{body-surface-proximal}~~ body-surface-proximal side and a ~~{body-surface-distal}~~ body-surface-distal side;

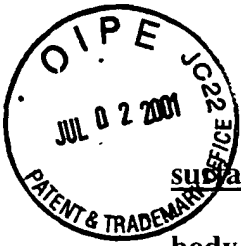
said member further having a first surface on the ~~{body-surface-proximal}~~ body-surface-proximal side of the member, a second surface on the ~~{body-surface-distal}~~ body-surface-distal side of the member and a plurality of protrusions capable of piercing said body surface; said protrusions extending from the first surface~~{and extending towards the body surface}~~; and

a connecting medium ~~{capable of storing the agent therein or passing the agent therethrough disposed on at least a portion of the first surface of the member.}~~ disposed on at least a portion of the first surface of the member, said connecting medium capable of storing the agent therein or passing the agent therethrough when the plurality of protrusions have pierced the body surface and said connecting medium is placed in contact with said body surface.

18. (amended three times) A device for introducing or withdrawing an agent through a body surface, comprising:

a member having a ~~{body-surface-proximal}~~ body-surface-proximal side and a ~~{body-surface-distal}~~ body-surface-distal side;

said member further having a first surface on the ~~{body-surface-proximal}~~ body-



surface-proximal side of the member, a second surface on the ~~[body surface-distal]~~  
body-surface-distal side of the member, an opening therethrough and a plurality of  
protrusions capable of piercing said body surface; said protrusions extending from the  
first surface~~[and extending towards the body surface]~~; and  
a connecting medium ~~[capable of storing the agent therein or passing the  
agent therethrough disposed on at least a portion of the first surface of the  
member.]~~ disposed on at least a portion of the first surface of the member and  
further disposed in the at least one opening, said connecting medium capable of  
storing the agent therein or passing the agent therethrough when the plurality of  
protrusions have pierced the body surface and said connecting medium is placed in  
contact with said body surface.